

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration of this application and reconsideration of the Office Action dated August 31, 2006. Applicants respectfully submit that this Amendment renders moot the various grounds of rejection raised in the August 31, 2006, Office Action. Withdrawal of these rejections and allowance of the pending claims are respectfully requested.

Upon entry of this Amendment, claims 1-30, 32, and 34-48 will be pending in this application. Claims 31 and 33 have been canceled.

The Office objected to the drawings under 37 C.F.R. 1.83 (a) as not showing every feature of the invention specified in the claims. *See* the August 31, 2006, Office Action at page 2. Replacement drawings are submitted with this Amendment to show the instructions permanently secured to the interior of the garment as required by 37 C.F.R. 1.121 (d). Support for this addition may be found in paragraph 30 of the original application.

The Office rejected claims 1-4, 6, and 7 as anticipated under 35 U.S.C. § 102 (b) based on Buonassissi, U.S. Patent No. 4,601,067. *See* the August 31, 2006, Office Action at page 3. For a claim to be anticipated by a reference, that reference must disclose each and every element of the claimed invention. *See The Manual of Patent Examining Procedure*, § 2131. If a claim contains even one element that is not disclosed in the reference, then the reference does not anticipate the claim. *Id.*

Here, claim 1, as amended, contains at least one element that is not disclosed in the Buonassissi reference. Buonassissi discloses a vest structure having an exterior and an interior, wherein the interior includes pockets to receive packs for cooling or warming an individual wearing the vest structure. Buonassissi further discloses a means for fastening the vest structure to a person's torso.

In contrast, Applicants' claim 1, as amended, defines an article of apparel that includes a torso region having a chest area that corresponds with a chest of an individual, a back area corresponding with a back of the individual, a pair of side areas corresponding with sides of the individual, and a pair of shoulder areas corresponding with shoulders of the individual. The

article of apparel also includes a plurality of cavities that are distributed throughout the torso region, wherein at least one cavity is positioned in the chest area, the back area, around each of the side areas, and at or near the top of the shoulder areas. A fitting system extends at least partially around the torso region to ensure contact between the individual and at least one of the chest area, the back area, and the side areas.

The Buonassissi reference fails to disclose that at least one cavity is positioned around each of the side areas. Additionally, Buonassissi fails to disclose that at least one cavity is positioned at or near the tops of the shoulder areas. Rather, pockets in Buonassissi are located in either the chest area or the back area. The pockets do not extend around the side areas nor are they positioned at or near the tops of the shoulder areas. Rather, the pockets in Buonassissi are positioned only on the back or chest area. Although the cavities of Buonassissi generally may be adjacent to the side areas and shoulder areas, they do not extend around the side areas, nor are they positioned at or near the tops of the shoulder areas. Therefore, Applicants' claim 1 defines at least one feature that is not taught in the Buonassissi reference. For this reason, Buonassissi does not anticipate claim 1. Furthermore, claims 2-4, 6, and 7 depend from claim 1, and thus these claims also are not anticipated by the Buonassissi reference. Applicants respectfully request that the Examiner withdraw the rejection of claims 1-4, 6, and 7, based on Buonassissi.

The Office also rejected claim 5 as unpatentable under 35 U.S.C. § 103 (a) based on Buonassissi, in view of Steele, et al., U.S. Patent No. 5,146,625. *See* the August 31, 2006, Office Action at page 4. The Office bears the burden of proving a *prima facie* case of obviousness under 35 U.S.C. § 103 (a). *See The Manual of Patent Examining Procedure*, § 2142. Every element of the claimed invention must be taught or suggested by the reference to render the claimed invention *prima facie* obvious. *Id.* A suggestion or motivation to combine the teachings of the references must be present either implicitly or expressly in the prior art references or must be generally known by one of ordinary skill in the pertinent art. *Id.* Furthermore, the Examiner must also show that a person having skill in the art would reasonably expect that the combination of the prior art references would successfully result in the claimed invention. *Id.* The Examiner must consider whether the claimed invention, as a whole, would be rendered obvious in view of the prior art references. *Id.* Moreover, the references that are relied upon by the Examiner to

support an obviousness rejection must also be considered as a whole and must be viewed without the benefit of impermissible hindsight obtained from the disclosure that supports the claimed invention. *Id.*

As noted by the Office at page 4 of the August 31, 2006, Office Action, the factual inquiry through which an Examiner must go *in conjunction with* identifying the appropriate prior art references upon which to rely for an obviousness rejection include: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence that is present in the application indicating obviousness or nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966).

Here, Applicants' claim 5, as amended, contains at least one element that is not disclosed in the combination of the Buonassissi reference in view of the Steele reference. As discussed above, Buonassissi fails to teach that the pockets are positioned around the sides of the vest, nor does it teach that the pockets may be positioned at or near the tops of the shoulder areas of the vest. The Examiner correctly points out that the cooling pack disclosed in Steele has multiple chambers, as shown in FIG. 2 and described at Col. 4, Lines 43-46. However, like Buonassissi, Steele fails to disclose that a pocket is positioned around the side areas or at or near the tops of the shoulder areas of the vest. Rather, Steele discloses that cooling packs may be inserted into pockets found only in either the chest or the back areas of the vest. Therefore, the combination of Buonassissi in view of Steele still fails to teach each and every element of the claimed invention. Applicants respectfully request that the Examiner withdraw the rejection of claim 5 under 35 U.S.C. § 103 (a).

The Office rejected claims 8-15, 17-25, 27-30, 34-43, and 45-48 as unpatentable under 35 U.S.C. § 103 (a) based on Buonassissi, in view of The Federal Trade Commission Rules. *See* the August 31, 2006, Office Action at pages 4-5. As noted above, the Office bears the burden of proving a *prima facie* case of obviousness under 35 U.S.C. § 103 (a). *See The Manual of Patent Examining Procedure*, § 2142.

Here, Applicants' claims 8, 12, 24, 30, 34, and 41 contain at least one element that is not disclosed in the combination of the Buonassissi reference in view of The Federal Trade Commission Rules. As discussed above, Buonassissi fails to teach that the pockets are positioned around the sides of the vest, nor does Buonassissi disclose that the pockets are positioned at or near the tops of the shoulder areas of the vest. The Federal Trade Commission Rules do not overcome these deficiencies of Buonassissi, nor are they relied upon by the Office for that purpose. Withdrawal of the rejections of these claims on this basis is respectfully requested.

Moreover, Applicants respectfully assert that The Federal Trade Commission Rules do not provide an adequate teaching of the subject matter for which they are cited. The Examiner alleges that The Federal Trade Commission Rules teach that an article of apparel has "instructions for *utilizing* the article of apparel." See The August 31, 2006, Office Action at pages 4-5. Rather, The Federal Trade Commission Rules teach that manufacturers and importers of clothing must attach *care* instructions to garments and do not mention that manufacturer may or must attach instructions for using the garment. See The Federal Trade Commission Rules at page 2. Care instructions "provide complete instructions about regular care for the garment, or provide warnings if the garment cannot be cleaned without harm." *Id.* Furthermore, care instructions warn consumers "about certain procedures that [the consumer] may assume to be consistent with the instructions on the label, but would harm the product." *Id.*

In contrast, claims 8, 12, and 24 require "instructions for utilizing" the article of apparel. Claims 8, 12, and 24 define instructions that provide a user with steps describing the manner in which the garment is to be used, rather than the manner in which the garment is to be cared or washed. The scope of the set of instructions that is required by The Federal Trade Commission Rules does not teach the manner in which a garment is to be used. See *generally*, The Federal Trade Commission Rules. The method recited in claim 30 defines steps through which a wearer may go for moderating body temperature with an article of apparel. These steps relate to the manner in which the article of apparel is *used* and do not define the manner in which the article of apparel may be cared or washed, which The Federal Trade Commission Rules teach. Claim 34, as amended, describes an article of apparel that includes a description of the manner in which

the article of apparel is to be *used* and not the manner for which it is to be cared, as described above.

Applicants respectfully assert that the Office has not correctly interpreted the requirement of claims 8, 12, and 24 that includes instructions for utilizing the article of apparel. *See* the August 31, 2006, Office Action at pages 4-5. More specifically, Applicants respectfully assert that the Examiner confuses the element of the instructions that describe the article of apparel's use with a description of the article of apparel's utility or function. Although the Examiner correctly states that the function of a claim fails to differentiate it from a prior art reference, the presence of the element of instructions being affixed to the article of apparel is not functional. Rather, the instructions are a tangible element of the claimed invention. Therefore, the presence of the instructions as an element of the claimed invention moots the Examiner's argument that the instructions merely describe the function of the invention.

The Examiner may not rely upon The Federal Trade Commission Rules for disclosing the *tangible element* of including instructions for utilizing the article of apparel. Rather, The Federal Trade Commission Rules disclose care instructions, as described above, and do not suggest placing instructions into the garment to instruct the wearer on the manner in which the garment may be used. One of ordinary skill in the art would not have included instructions relating to the manner in which the article of apparel is to be used based on the disclosure in The Federal Trade Commission Rules because the use of the article of apparel is not related to the manner in which the garment is to be cleaned and cared. The Federal Trade Commission Rules require a manufacturer to "articulate a method for properly cleaning [the garment]." Instructions relating to the use of the article of apparel are not related in subject matter nor are they required to be included in a garment as required by The Federal Trade Commission Rules. Therefore, a person having ordinary skill in the art of manufacturing garments would not have been motivated to place instructions for utilizing the article of apparel into a garment based on the disclosure in The Federal Trade Commission Rules.

Claims 13-15 and 17-23 depend from claim 12, claims 25 and 27-29 depend from claim 24, claims 35-40 depend from claim 34, and claims 42-48 depend from claim 41. These claims are not obvious over the combination of the Buonassissi reference in view of The Federal Trade

Commission Rules for the same reasons as discussed above for claims 12, 24, 34, and 41, respectively. The Applicants respectfully request that the Examiner withdraw the rejection of claims 8-15, 17-25, 27-30, 34-43, and 45-48 based on the combination of Buonassissi in view of The Federal Trade Commission Rules.

The Office rejected claims 31-33 as unpatentable under 35 U.S.C. § 103 (a) based on Buonassissi. *See* the August 31, 2006, Office Action at page 5. The Office is required to carry the burden of proving *prima facie* obviousness, as described above. Here, Applicants' claims 31-33, as amended, contain at least one element that is not disclosed in the Buonassissi reference. Claim 31, as amended, requires that a cavity be positioned around a side area of the torso. In contrast, Buonassissi fails to disclose that a pocket is positioned around a side area of the vest, as described in detail above. Furthermore, Buonassissi does not inherently or expressly teach that a pocket may be positioned around the side area of the torso. Nor would one skilled in the art have been motivated to extend a pocket around the side area of the torso after consulting the Buonassissi reference because Buonassissi leaves the vest sides unattached to allow inclusion of size adjustment straps. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of claims 31-33 based on Buonassissi.

The Office rejected claims 16, 26, and 44 under 35 U.S.C. § 103 (a) as being unpatentable over Buonassissi in view of The Federal Trade Commission Rules and further in view of Steele. As discussed above in detail, Buonassissi fails to teach that cavities extend around each of the side areas and at or near the tops of the shoulder areas of the article of apparel. As also discussed above, The Federal Trade Commission Rules disclose that instructions to care for the garment may be positioned within the garment, but this reference fails to disclose that cavities extend around each of the side areas and at or near the tops of the shoulder areas of the article of apparel. Additionally, Applicants respectfully submit that Steele fails to disclose cavities that may be placed around the side areas or at or near the tops of the shoulder areas of a garment. Therefore, none of Buonassissi, The Federal Trade Commission Rules, or Steele teaches that cavities may be placed around the side areas or at or near the tops of the shoulder areas of an article of apparel. Accordingly, Applicants respectfully request that the

Examiner withdraw the rejection of claims 16, 26, and 44 based the combination of Buonassissi in view of The Federal Trade Commission Rules and further in view of Steele.

Nothing in this Amendment should be construed as an admission that Applicants agree with or acquiesce on the various grounds of rejection that were raised by the Office in the August 31, 2006, Office Action. Rather, by this Amendment, Applicants have presented various claim amendments in an effort to expedite prosecution and to facilitate the immediate allowance of this application. The claim changes made in this Amendment are presented without prejudice or disclaimer, and Applicants reserve all rights with respect to the originally and/or previously claimed subject matter, including the right to pursue claims of the same or similar scope in the future (*e.g.*, in a continuing application).

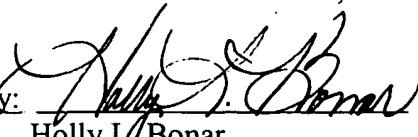
If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or to place the application in condition for allowance, he is invited to contact the undersigned attorney.

If any fees are due in connection with this Amendment, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pending status of this application.

All rejections having been fully addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By: 
Holly L. Bonar
Registration No. 59,496

Application of Scott E. Williams, et al. – U.S. Patent Appln. No. 10/821,636

BANNER & WITCOFF, LTD.

1001 G Street, N.W.

Washington, D.C. 20001

Telephone: (503) 425-6800

Facsimile: (503) 425-6801

Dated: November 29, 2006